

REMARKS

The Examiner is thanked for the careful examination of the application. However, in view of the foregoing amendments and the remarks that follow, the Examiner is respectfully requested to reconsider and withdraw the outstanding rejections.

By the foregoing amendments, the independent claims have been amended. Some of the dependent claims have been amended to conform to the amendments in the independent claims and new dependent claims 37-41 have been added.

Claim Rejections – 35 U.S.C. §112:

The Office Action alleges that claims 1-32, 35, and 36 have been amended so that they contain subject matter which was not described in the specification in such a way to reasonably convey to one skilled in the art that the inventors at the time that the application was filed had possession of the claimed invention. In particular, the Examiner is concerned about the use of the word "figure or figures". In response to this rejection, each of the independent claims has been amended to remove such language identified by the Examiner. Accordingly, the Examiner is respectfully requested to reconsider and withdraw the rejection of claims 1-32, 35, and 26 under 35 U.S.C. §112, first paragraph.

Claims 34-36 have been rejected under 35 U.S.C. §112, second paragraph. With regard to claim 34, the Examiner alleges that the claim does not clearly define when the user establishes the perimeter. However, claim 34 now clearly states that the perimeters established by the user before the extracting step. Claims 35 and 36 have been canceled. Accordingly, the Examiner is respectfully requested to

reconsider and withdraw the rejection of claims 34-36 based on 35 U.S.C. §112, second paragraph.

35 U.S.C. §101:

As requested by the Examiner, claims 9-16, 21-23, and 29 have been amended to now claim "a computer readable medium for storing a program for causing a computer to execute imaging processing comprising the steps of:".

The Examiner alleges that independent claim 9 is a program claim that can cause by is not claimed to cause a computer to execute image processing steps. However, as now amended, the claim recites specific steps within a program that is stored on a computer readable medium. Accordingly, claim 9 complies with 35 U.S.C. §101.

The Examiner alleges that independent claim 17 is a method claim that is not limited to a computer implemented process, thus it allegedly covers mental steps which is allegedly unstatutory. First, Applicants dispute that the subject matter of claim 17 is directed to unstatutory mental steps. Specifically, the method of claim 17 includes concrete specific steps, including generating character code data, reconstructing the at least one document block, and laying out the generating character code data. Whether such concrete steps are implemented by a computer or a human being should not affect their patentability. If the Examiner persists with the rejection that the subject matter of claim 17 is not statutory, the Examiner is respectfully requested to recite some authority.

Claim 1 is rejected as being a means plus function claim. The Examiner alleges that a person performing mental steps would be equivalent to the disclosed computer process. Applicants question whether a person would be considered

"equivalent" to the embodiments disclosed in the specification for performing the recited functions. Nevertheless, even if the Examiner's position was accepted, i.e., that the person is "equivalent" to the disclosed computer, it is not clear why such a comparison would render the claims unstatutory. The claims require clearly definable steps.

As for claims 27, 32, and 33, which are directed to a circuit, the Examiner said that such a term is met by a person performing mental steps. However, the Examiner's attention is directed to the recent case in *Linear Technology Corp. v. Impala Linear Corp.*, decided August 17, 2004, by the Federal Circuit. In that case, the Court stated, "Technical dictionaries, which are evidence of the understandings of persons skilled in the technical arts, plainly indicate that the term 'circuit' connotes structure." Accordingly, the Examiner is respectfully requested to reconsider and withdraw the rejections based under 35 U.S.C. §101.

Art Rejections:

Claims 1-33 and 36 have been rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,179,650, hereinafter *Fukui*. In response to this rejection, the Examiner is referred to the comments submitted in this application on January 19, 2005. Such comments are incorporated herein by reference.

In addition to such arguments previously made, the claims of the present application have been significantly amended to more clearly distinguish the present invention from the applied prior art. Specifically, referring to claim 1, the recognition means is now defined as generating means for generating character code data for a character image within the at least one document block. Support for this amendment may be found on page 13, lines 11-14; page 11, lines 16-21, and page 12, lines 9-

11. Similar amendments have been made in all of the other independent claims in the application.

As now amended, the present invention is clearly distinguishable over *Fukui*. Specifically, *Fukui* does not teach or suggest the combination of the independent claims, in particular the step of generating character code data for character images within the document blocks. The Examiner makes reference to column 4, lines 43-44 and step 1 of 3 in *Fukui* for the former step of "recognition means". However, the foregoing claim amendments clearly distinguish the subject matter of the present invention over at least this portion of *Fukui*. *Fukui* does not teach or suggest generating character code data for character images.

By generating character code data for the character images, the present invention includes several advantages over *Fukui* including a reduction in the amount of data necessary to layout the new document image.

In view of the foregoing amendments and remarks, the Examiner is respectfully requested to reconsider and withdraw the outstanding rejections.

In the event that there are any questions concerning this amendment, or the application in general, the Examiner is respectfully urged to telephone the undersigned attorney so that prosecution of the application may be expedited.

Respectfully submitted,

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